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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JORG GREGOR SCHLEICHER,
and CHRISTOPHER ALLIN KITZE

Appeal 2009-004943
Application 09/963,812
Technology Center 3600

Before, MURRIEL E. CRAWFORD, ANTON W. FETTING and JOSEPH
A. FISCHETTI, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1-29. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM (37 C.F.R. § 41.50(b)).

THE INVENTION

Appellants claim a system and method for generating revenue in a peer-to-peer file delivery network. (Specification 1: 10-11).

Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A method for generating revenue in a peer-to-peer file delivery network, the peer-to-peer file delivery network including at least one server node and multiple client nodes, the method comprising the steps of:
 - (a) enabling peer-to-peer file sharing of content by,
 - (i) initiating on one client node a download of a particular content item served from the server node or another client node, and
 - (ii) charging a fee based on a quantity of content served related to the particular content item; and
 - b) enabling decentralized downloads of subscription-based content by
 - (i) allowing client nodes of the multiple client nodes to subscribe to the subscription-based content,
 - (ii) periodically sending the subscription-based content to each respective subscribing client node, and

(iii) charging a fee to providers of the subscription-based content for serving the subscription-based content.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Ferguson	US 5,819,092	Oct. 6, 1998
Ricci	US 2002/0062290 A1	May 23, 2002

The following rejections are before us for review.

The Examiner rejected claims 1-6, 9-14, 17-22, and 26-29 under 35 U.S.C. § 103(a) as being unpatentable over Ricci in view of Ferguson.

The Examiner rejected claims 7, 8, 15, 16, and 23-25 under 35 U.S.C. § 103(a) as being unpatentable over Ricci in view of Ferguson and further in view of the Appellants' Related Art (hereinafter "ARA").

The Examiner rejected claims 1-27 under the judicially created doctrine of obviousness-type double patenting as being provisionally unpatentable over claims 16 and 17 of co-pending U.S. Patent Application No. 08/814,319 in view of Ferguson.

ISSUE

The issue of obviousness turns on whether a person with ordinary skill in the art would understand that the request in Ricci, being formed by the

client, is thus not generated by a subscription which would periodically send subscription-based content.

FINDINGS OF FACT

We find the following facts by a preponderance of the evidence:

1. The Specification describes periodically sending the subscription-based content to each respective subscribing client node as:

According to one aspect of the present invention, client nodes 14 may subscribe to one or more of the subscription-based content, and in return, the subscribed to content is periodically sent to each the respective subscribing client nodes 14 either from the server node 12 or from another nearby client node. Providers of the subscription-based content are then charged a fee for the serving the content to the client nodes in step 48.

(Specification 9:17-21).

ANALYSIS

I. The rejection of claims 1-27 provisionally rejected under the judicially created doctrine of obviousness-type double patenting is summarily sustained because Appellants concede the rejection and will be filing a terminal disclaimer. (Appeal Br. 20).

II. We will not sustain the rejection of independent claims 1, 17, 25, and 26 under 35 U.S.C. § 103(a).

Independent claims 1, 17, 25, and 26 each require “periodically sending subscription-based content to each subscribing client node”.

Appellants argue that “... none of the references, either alone or in

combination, disclose periodically sending subscription-based content to each subscribing client node.” (Appeal Br. 13)

Appellants’ Brief references the Specification at page 9 lines 17-19 as describing “(ii) periodically sending the subscription-based content to each respective subscribing client node” (FF1). Here, the Specification describes that the “client nodes 14 may subscribe to one or more of the subscription-based content, and in return, the subscribed to content is periodically sent to each the respective subscribing client nodes....”

The Examiner maintains that Ricci discloses this feature because

...Ricci discloses digital and advertisement information (subscription- based content) and the system sending the information to a user. Furthermore, Ricci discloses the server can change the advertisements being sent to prevent repeats (0067). Therefore, Ricci discloses changing advertisements sent to the user, which also indicates, periodically sending the subscription-based content to each respective subscribing client node.

(Answer 13).

However a closer review of Ricci shows that the advertisements “are added to a user request for content” and the request is formed by the client, [0060, 0064], and not in turn by a subscription which generates periodically sending of the subscription-based content. So much so is this the case that a “unique key is created for each digital media piece and user” and transmitted to the individual recipient. (Ricci, ¶ [0063]).

The Examiner reasons that “the advertisement could also be set to play every time that the digital media is opened (where the server downloads an advertisement to the recipient)’, is also taken to be periodically sending content to the user.” (Answer 13).

We disagree with the Examiner because as discussed above, the advisement being sent with the content would be sent only once, and any further replaying of it would not involve periodic sending of the content because the *send* step already occurred.

Since claims 2-8, 18-24 depend from claims 1 and 17, and since we cannot sustain the rejection of claims 1 and 17, the rejection of these claims likewise cannot be sustained.

III. Claims 9-16 and 27

As further explained below, we will enter a new ground of rejection of independent claims 9 and 27 under 35 U.S.C. § 112, second paragraph, because they are indefinite. Therefore, the rejection over prior art must fall, pro forma, as being necessarily based on speculative assumptions as to the scope of this claim. *See In re Steele*, 305 F.2d 859, 862-63 (CCPA 1962). Our decision in this regard is based solely on the indefiniteness of the subject matter and does not reflect on the adequacy of the prior art evidence applied in support of the rejection.

IV. Claims 28 and 29

We will sustain the rejection of claims 28 and 29 under 35 U.S.C. § 103(a).

The Examiner found that the limitations of claims 28 and 29 are met under 35 U.S.C. § 103(a) in the combination of over Ricci in view of Ferguson (Answer 6-7, 16, 17).

Appellants only argument against the combination is that neither reference either alone or in combination discloses the “charging a fee ...” limitation on claim 28 and the “percentage of fee...” limitation of claim 29. (Appeal Br. 19).

We will sustain the rejection of claims 28 and 29 under 35 U.S.C. § 103(a) because Appellants’ arguments regarding the “charging a fee...” and the “percentage of fee...” limitations are no more than general allegations that those limitations are not described by Ricci in view of Ferguson. “It is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for nonobvious distinctions over the prior art.” *In re Baxter Travenol Labs*, 952 F.2d 388, 391 (Fed. Cir. 1991). *See also In re Wiseman*, 596 F.2d 1019, 1022 (CCPA 1979) (arguments must first be presented to the board). A general allegation that the art does not teach any of the claim limitations is no more than merely pointing out the claim limitations. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim. 37 C.F.R. § 41.37(c)(1)(vii).

V. Pursuant to 37 C.F.R. § 41.50(b), we enter a new ground of rejection for claims 9-16 and 27 under 35 U.S.C. § 112, second paragraph as being indefinite.

Independent claim 9 requires “means for enabling decentralized downloads of subscription-based content that client nodes of the multiple client nodes subscribe to in order to receive periodic updates, wherein a fee is charged to providers of subscription-based content for serving the subscription-based content to the client nodes.”

Appellants’ Appeal Brief at the SUMMARY OF CLAIMED SUBJECT MATTER refers to the Specification at: p. 5, lines 1-5, and p. 9, lines 14-19; see also Figure 2, step 46, Figure 3D, steps 140 and 148), and p. 5, lines 5-6, and p. 9, lines, 19- 20; see also Figure 2, step 48, as disclosing this feature. (Appeal Br. 4).

Independent claim 27 requires “means for enabling client nodes to become affiliate servers that deliver content to other client nodes, such that owners of the affiliate servers are paid a percentage of the fee charged for serving files.”

Appellants’ Appeal Brief at the SUMMARY OF CLAIMED SUBJECT MATTER refers to the Specification at page 5 lines 10-14 as disclosing this feature. (Appeal Br. 8).

We have reviewed the Specification disclosure at the listed points referenced by Appellants in the Appeal Brief at the SUMMARY OF CLAIMED SUBJECT MATTER, but have not been able to discern the algorithm corresponding to the functions, “means for enabling decentralized downloads of subscription-based content that client nodes of the multiple client nodes subscribe to in order to receive periodic updates, wherein a fee is charged to providers of subscription-based content for serving the

subscription-based content to the client nodes”, and “means for enabling client nodes to become affiliate servers that deliver content to other client nodes, such that owners of the affiliate servers are paid a percentage of the fee charged for serving files.”

In effect, the Specification repeats, in different words, the function at issue. There is no disclosure that explains the structure of the algorithm itself that would cause the recited function to be performed. Also, there is no evidence on the record that one of ordinary skill in the art at the time of the invention would have understood what this algorithm would be. Given all this, we find that the Specification does not adequately describe an algorithm corresponding to the involved functions such that one of ordinary skill in the art could determine the scope of independent claims 9 and 27.

For the foregoing reasons, we find that the Specification does not adequately describe an algorithm corresponding to the functions of “means for enabling decentralized downloads of subscription-based content that client nodes of the multiple client nodes subscribe to in order to receive periodic updates, wherein a fee is charged to providers of subscription-based content for serving the subscription-based content to the client nodes” and “means for enabling client nodes to become affiliate servers that deliver content to other client nodes, such that owners of the affiliate servers are paid a percentage of the fee charged for serving files”. The Specification fails to disclose an algorithm corresponding to the recited functions at issue in claims 9 and 27 such that one of ordinary skill in the art could determine

the scope of claims 9 and 27. Accordingly, we reject claims 9-16 and 27 under 35 U.S.C. § 112, second paragraph, as being indefinite.

CONCLUSIONS OF LAW

We conclude the Examiner did not err in rejecting claims 28 and 29 under 35 U.S.C. § 103(a).

We conclude the Examiner did not err in rejecting claims 1-27 under 35 U.S.C. § 103(a) as 1-27 provisionally rejected under the judicially created doctrine of obviousness-type double patenting.

We conclude the Examiner erred in rejecting claims 1-27 under 35 U.S.C. § 103(a).

We enter a new grounds of rejection of claims 9-16 and 27 under 35 U.S.C. § 112, second paragraph, as being indefinite.

DECISION

In addition to affirming the Examiner's rejection(s) of one or more claims, this decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” This Decision contains a new rejection within the meaning of 37 C.F.R. § 41.50(b) (2007).

37 C.F.R. § 41.50(b) also provides that Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new rejection:

- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the Examiner, in which event the proceeding will be remanded to the Examiner. . . .
- (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should the Appellants elect to prosecute further before the examiner pursuant to 37 CFR § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the Appellants elect prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED; 37 CFR § 41.50(b).